

Serial No. 09/653,735
Attorney Docket No. 65678-0032

REMARKS

I. INTRODUCTION

In the Office Action: claims 1-7 and 12-24 were rejected under 35 U.S.C. 103(a) as being obvious over US Patent No. 5,875,430 ("Koether") in view of US Patent No. 6,230,081 ("Albertshofer"); and claim 8 was rejected under 35 U.S.C. 103(a) as being obvious over Koether and Albertshofer as applied to claim 1, and further in view of US Patent No. 6,003,808 ("Nguyen").

Claims 1-8 and 12-24 are currently pending. No claims have been cancelled in this amendment. Claim 5 was amended solely to correct a typographical error. Applicant respectfully traverses Examiner's rejections and submits that all pending claims are in condition for allowance. Alternatively, applicant respectfully requests that the Office withdraw the finality of the Office Action and reopen prosecution of the present application. With regards to the Section 103 rejections, the cited references do not disclose each and every element of the claimed invention. Moreover, the cited references do not affirmatively suggest their combination.

Applicant notes that the examiner made an argument on page 2 of the Office Action about "need[ing] to consider only the alternative" of "conditional statements." To the extent the examiner is arguing that applicant's claims recite conditional limitations, applicants respectfully disagree. An alternative limitation would recite doing either A or B, whereas applicant recites affirmative, non-optional limitations wherein the limitation happens to require imposing a condition to complete the recited method step or system element. Accordingly, to reject each claim the examiner must apply prior art that teaches performing all of the actions required by the limitation. The examiner's argument that Koether teaches storing historical information has been addressed below.

II. THE IMPROPERLY FINALITY OF THE OFFICE ACTION

In the event the examiner is unpersuaded by the arguments below that all pending claims are in allowable condition, applicant respectfully requests that the Office withdraw the finality of the Office Action and reopen prosecution of the present application. Applicant advances two independent reasons why the Office Action was improperly

Serial No. 09/653,735
Attorney Docket No. 65678-0032

made final: (1) the examiner did not respond at all to a number of applicant's arguments traversing the examiner's rejections and therefore there are issues between the examiner and the applicant that are not ripe for appeal, and (2) the examiner's rejections of the claims, as currently stated, are not sufficiently detailed so as to make the issues between the examiner and the applicant sufficiently developed for appeal.

A. THE EXAMINER'S FAILURE TO RESPOND TO ALL OF APPLICANT'S ARGUMENTS

There can be no debate that the examiner has a clear duty to specifically respond to each of applicant's arguments, and that the examiner must do so before an action can properly be made final. Section 706.07 of the MPEP clearly states that

Before final rejection is in order a clear issue should be developed between the examiner and applicant. . . . The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

Moreover, Section 706.07 states that the final rejection "should include a rebuttal of any arguments raised in the applicant's reply" to the examiner's last rejections. Similarly, MPEP 707.07(f) states that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

In the Remarks filed July 14, 2003 applicant made a number of arguments to which the examiner wholly failed to respond. These arguments include the following:

- The prior art of record does not teach a plurality of operating characteristics used to set the lease rate as recited in claim 5. (Page 11, lines 19-21.)
- The prior art of record does not teach using maintenance information to affect lease rate as recited in claims 7, 18, 21, and 22. (Page 12, lines 2-3 and lines 17-19.)
- The prior art of record does not teach a hybrid lease arrangement as recited in claim 22. (Page 12, lines 26-27.)
- Claim 20 should be rejected on the same grounds as claim 8, inasmuch as these claims contain similar limitations. (Page 13, lines 4-6.)

Serial No. 09/653,735
Attorney Docket No. 65678-0032

- US Patent No. 6,003,808 to Nguyen merely teaches the generation of a warranty claim for a particular asset and as such is wholly irrelevant to applicant's claims. (Page 13, line 7.)

Further, the examiner ignored applicant's request, originally made on page 11 of the Remarks filed July 14, 2003, for a supporting affidavit or an appropriate reference in the context of the claimed invention if the Examiner is going to maintain the rejection of any claims based on Official Notice. (Moreover, applicant traverses the examiner's assertion (Office Action, page 2) that applicant's statement that "surcharges *may* be old" (emphasis added) constitutes an admission by applicant of what was officially noticed.)

As is clear from the instances cited in the preceding paragraph, the record contains issues inadequately developed for appeal because the examiner has left the record silent regarding the examiner's position and reasoning with respect to a number of issues material to the rejection of applicant's claims. For example, although claim 5 stands rejected, nowhere does the examiner explain how the prior art of record teaches a plurality of operating characteristics used to set the lease rate as recited in claim 5. Thus, in preparing an appeal, applicant has no basis on which to respond to the examiner's reasoning in applying the prior art of record to claim 5, because that reasoning has not been revealed anywhere in the record. To take another example, in failing to respond to applicant's argument that claims 8 and 20 contain similar subject matter, the examiner has left the record confused as to the grounds of rejection for claim 20. Applicant submits that these holes in the record leave issues that are inadequately developed for appeal. Therefore, applicant respectfully submits that finality in this case was premature, and prosecution should be reopened.

B. THE "OMNIBUS" REJECTION OF CLAIMS 1-7 AND 12-24

The examiner rejected claims 1-7 and 12-24 under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,875, 430 ("Koether") in view of U.S. Patent No. 6,230,081 ("Albertshofer"). All of these claims were rejected together in a single paragraph that fails to separately identify each claim and its limitations, and fails to state how the prior art of record applies to each limitation of each claim. Instead, the Office

Serial No. 09/653,735
Attorney Docket No. 65678-0032

Action on page 4 provides a list of disclosures by Koether without identifying the claim limitations on which the examiner believes each of these disclosures reads. None of the listed disclosures matches limitations in applicant's claims, and the examiner has therefore left it to applicant to guess which claim limitation is being rejected by the listing of a given disclosure by Koether.

Further, it appears that the examiner intended many of the listed disclosures to be combined with disclosure from Albertshofer or the examiner's taking of Official Notice. However, because of the examiner's failure to identify specific claims, much less specific claim limitations, to which the prior art of record is being applied, it is impossible for applicant to determine what the Office believes to be the basis for an obviousness rejection of each claim. In particular, the examiner has not adequately explained what combination of elements from each cited reference would have rendered each recited claim limitation obvious. Moreover, as discussed in detail below, the examiner failed to meet the burden of a *prima facie* case of obviousness, because the examiner failed to state a motivation for one of ordinary skill in the art to have combined the cited references.

Accordingly, applicant respectfully submits that for this second, independent reason, finality in this case was premature, and prosecution should be reopened.

II. CLAIM REJECTIONS USING KOETHER IN VIEW OF ALBERTSHOFER

In the Office Action, claims 1-7 and 12-24 were rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,875, 430 ("Koether") in view of U.S. Patent No. 6,230,081 ("Albertshofer"). The cited references do not teach every recited limitation in applicant's independent claims. Moreover, this deficiency notwithstanding, with respect to every pending claim the examiner's burden of establishing a *prima facie* case of obviousness has not been met. In particular, as discussed in detail below, neither Koether nor Albertshofer teach determining a variable lease rate based on an asset's operating characteristics, much less do they provide any motivation to do so.

Independent claim 1 recites the limitation of "a sub-system that analyzes said at least one operating characteristic of the asset to determine a lease rate for the asset, the

Serial No. 09/653,735
Attorney Docket No. 65678-0032

lease rate being a variable". The prior art of record does not teach this claim limitation, either separately or in combination.

The examiner concedes that "Koether doesn't explicitly recite determining a lease rate." (Office Action, page 4.) However, the examiner asserts that "Albertshofer teaches an asset usage monitoring system that monitors asset performance . . . to determine a leasing rate." (Office Action, pages 4-5.) As applicant argued on pages 10-11 of the Remarks filed July 14, 2003, neither the portions of Albertshofer cited by the examiner, nor any other portions of Albertshofer, teach determining a lease rate for an asset, much less determining a *lease rate* based on analysis of least one of the asset's operating characteristics. Rather, Albertshofer teaches calculating a *total lease amount* as "a function of the usage duration of the vehicle or its distance-gone." (Albertshofer, col. 2, lines 36-38.)

Thus, it should be clear that when the Office Action or these Remarks refer to the "lease rate" taught by Albertshofer, what is really being referred to is a total lease amount. A total lease amount is clearly different from what is recited in claim 1, a lease rate that is a variable that can be used to calculate a total lease amount. Inasmuch as Albertshofer's disclosure is directed toward one-time usage of golf carts (Albertshofer, col. 1, lines 8-10), Albertshofer neither mentions nor teaches toward a variable lease rate such as that recited in independent claim 1. The examiner's argument that Albertshofer necessarily teaches "a variable 'lease rate', as the lease price is a function of a variable" (Office Action, page 3) ignores the significant distinction between a total lease amount that can change, which is all Albertshofer teaches, and a lease rate used as a variable to determine a total lease amount, which Albertshofer neither teaches nor suggests.

By citing the definition of "rate" found in Webster's Ninth Collegiate Dictionary (Office Action, page 5) the examiner appears to be arguing that the total lease amount taught by Albertshofer is actually a "rate" according to commonly understood definitions of that term. Assuming for the sake of argument that Webster's Ninth Collegiate Dictionary was published prior to the instant application and that it provides commonly accepted definitions of the word "rate", applicant maintains that Albertshofer does not teach the variable lease rate recited in independent claim 1. If the examiner intends to

Serial No. 09/653,735
Attorney Docket No. 65678-0032

argue that the rate in Albertshofer is an "amount . . . measured per unit of something else" or "an amount of payment or charge based on another amount", applicant agrees, inasmuch as Albertshofer teaches usage charges based on operating statistics. That is, Albertshofer teaches analyzing operating characteristics to determine a "rate" insofar as the "rate" is simply an amount based on another amount or measurement, and insofar as the "rate" is an amount to be charged for usage of a golf cart. However, Albertshofer does not teach determining a lease rate that can then be used as a variable in the calculation of the amount to be charged for a lease. Specifically, Albertshofer does not teach or suggest analyzing at least one operating characteristic of an asset to determine a lease rate for the asset, the lease rate being a variable, as recited in independent claim 1.

Further, assuming *arguendo* that Albertshofer does teach a lease rate as recited in claim 1, the examiner has not met the burden of making a *prima facie* case of obviousness because the examiner has not provided a motivation for one of ordinary skill in the art to have combined Koether and Albertshofer. As stated in Section 2143 of the MPEP:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The examiner has not provided the required suggestion or motivation to combine reference teachings. Neither do the cited references provide the required motivation.

The closest the examiner comes to stating a motivation to combine the cited references is the statement on page 5 of the Office Action that, following the definition of the word "rate" found in the dictionary, it would have been obvious to one of ordinary skill in the art to calculate a rate based on any "quantity, amount, or degree of something within the scope of knowledge and understanding of one of ordinary skill in the appropriate art." In other words, because a rate may be based on any quantity it would have been obvious to calculate a rate based on any quantity. Not only does this reasoning fail to address why one of ordinary skill in the art would have wished to calculate a rate, the examiner provides no explanation of why one of ordinary skill in the art would have

Serial No. 09/653,735
Attorney Docket No. 65678-0032

wished to analyze an operating characteristic of an asset to determine a lease rate for the asset.

Claims 2-4 each depend from claim 1 and recite the respective limitations of: wherein said lease rate includes a minimum charge if said operating characteristic is below a pre-determined threshold, wherein said lease rate includes a surcharge if said operating characteristic is above a pre-determined threshold and wherein said lease rate includes a minimum charge if said operating characteristic is below a pre-determined threshold and a surcharge if said operating characteristic is above a pre-determined threshold.

The Office Action failed to cite prior art teaching the lease rate including a minimum charge. The examiner may have been attempting to justify this omission by stating on page 3 of the Office Action that "the examiner need only consider the alternative" when rejecting "conditional limitations". If so, applicant respectfully disagrees that the instant limitation is alternative. An alternative limitation would recite doing either A or B, whereas the instant limitation recites doing *both* A (imposing a minimum charge if a certain condition is met) *and* B (imposing a surcharge if a certain condition is met) simultaneously. Accordingly, to reject claim 1 the examiner must apply prior art that teaches performing both of the actions required by the instant limitation.

With respect to the lease rate including a surcharge, the examiner took "Official Notice that surcharges and the appliance [*sic*] of surcharges are old and well-known to those of ordinary skill in the art." (Office Action, page 4.) The rejection of claims 2-4 contains no statement of any motivation to apply the allegedly well known concept of a surcharge to a lease rate if an operating characteristic is above a certain threshold.

In paragraph number 2 of the Office Action the examiner ¹cites the definition of "surcharge" from Webster's Ninth Collegiate Dictionary and states that from this definition "to apply a surcharge is at least an obvious method of increasing revenues on the part of the party applying the surcharge." However, the examiner does not explain, and it is not readily apparent, how the mere definition of a surcharge would have motivated one of ordinary skill in the art to include a surcharge in a lease rate if an operating characteristic is above a certain threshold.

Serial No. 09/653,735
Attorney Docket No. 65678-0032

Accordingly, claims 2-4 are each believed to be in condition in allowance apart from the fact that they each depend from claim 1, which is itself in condition for allowance.

Claim 5 (which has been amended solely to correct a typographical error) depends from claim 1, and is allowable for that reason alone. Further, claim 5 was not fully addressed in the Office Action. Moreover, the prior art of record does not teach or suggest using a plurality of operating characteristics to determine a lease rate, the lease rate being a variable.

Claim 6 depends from claim 5, and is allowable for that reason alone. Further, claim 6 was not fully addressed in the Office Action. Assuming *arguendo* that Koether teaches monitoring a plurality of characteristics over a fixed period of time as asserted on page 4 of the Office Action, nothing in Koether teaches or suggests using the operating characteristics to determine a lease rate. Further, while Albertshofer arguably does talk about "time of operation within a fixed period of time", once again the operating characteristic is used to adjust the lease rate acting as a variable as opposed to being another number multiplied by a fixed lease rate to determine an overall lease amount. In Albertshofer, the time of operation is multiplied by a pre-determined lease rate set as a constant.

Claim 7 depends from claim 1, and is allowable for that reason alone. Further, claim 7 was not fully addressed in the Office Action. Assuming *arguendo* that Koether teaches receiving operating characteristics adjusted by maintenance information to provide overall asset utilization as asserted on page 4 of the Office Action, nothing in either Koether or Albertshofer teaches maintenance information affecting a lease rate.

Claim 12 depends from claim 1, and is allowable for that reason alone. Moreover, the portion of Koether cited by the examiner (column 4, lines 22-26) does not teach that the asset is limited to motion in a pre-determined geographic region to ensure the acquisition of data. Rather, Koether teaches that kitchen appliances are located within cells of a communications network. (Koether, column 4, lines 22-24.) In view of the fact that the kitchen appliances taught by Koether were not moveable assets, it is

Serial No. 09/653,735
Attorney Docket No. 65678-0032

spurious to suggest that Koether teaches that the asset is limited to motion in a pre-determined geographic region to ensure the acquisition of data.

Independent claim 13 is a method claim reciting limitations similar to those found in claim 1, and is patentable for the reasons advanced above regarding claim 1. In addition, nowhere does the examiner cite any prior art teaching or suggesting at least one operating characteristic representing an objective criteria, nor does the prior art of record teach this limitation.

Claims 14-17 depend from claim 13 and are allowable for that reason alone. Further, these claims contain limitations similar to those found in claims 2-4, and are each patentable for the reasons advanced above regarding those claims.

Independent claim 18 is a method claim with certain limitations in common with those found in claim 1, and is patentable for the reasons advanced above regarding claim 1. In addition, claim 18 has limitations in common with claim 7, and is patentable for the reasons advanced above regarding claim 7.

Claims 19 depends from claim 18 and are allowable for that reason alone. Further, this claim contains limitations similar to those found in claims 2-4, and are each patentable for the reasons advanced above regarding those claims.

Claim 21 depends from claim 1, and is allowable for that reason alone. Further, this claim recites that the lease rate is lower if timely maintenance is performed and that the lease rate is higher if the maintenance is untimely. These limitations are not taught in the prior art of record.

Claim 22 depends from claim 1, and is allowable for that reason alone. Further, the prior art of record does not teach or suggest the recited hybrid lease arrangement.

Claim 23 depends from claim 22, and is allowable for that reason alone. Further, there is no teaching or suggestion in the cited prior art of an operating characteristic being utilization as claimed in the present invention.

Claim 24 depends from claim 22, and is allowable for that reason alone. Further, claim 24 is patentable for the reasons advanced above regarding claim 21.

Serial No. 09/653,735
Attorney Docket No. 65678-0032

III. CLAIM REJECTIONS USING KOETHER IN VIEW OF ALBERTSHOFER AND FUTHER IN VIEW OF NGUYEN

The examiner rejected claim 8, which contains subject matter incorporated from cancelled claim 11, as being unpatentable over Koether, Albertshofer, and further in view of US Patent No. 6,003,808 ("Nguyen"). In the Remarks filed July 14, 2003, applicant observed that the examiner apparently meant to include claim 20 in the rejection of claim 11 using the third reference since it includes very similar limitations. However, the examiner neither responded to this observation nor included claim 20 in the rejection using the third reference. Thus, claim 20 is clearly patentable inasmuch as the examiner acknowledges that neither Koether nor Albertshofer teach "analyzing maintenance information to evaluate a relationship based on maintenance performance." (Office Action, page 6.) In the event that the examiner did intend to include claim 20 in the rejection using Nguyen, the arguments below regarding claim 8 are equally applicable to claim 20.

Claim 8 depends from claim 1, and is allowable for that reason alone. Further, claim 8 was not fully addressed in the Office Action. Assuming *arguendo* that Koether teaches an asset user, asset owner, and asset supplier and a maintenance organization as asserted on page 4 of the Office Action, nothing in Koether or Albertshofer teaches or suggests an asset owner analyzing maintenance information for a plurality of assets associated with at least one of said asset supplier and said maintenance organization to evaluate its relationship based on overall maintenance performance.

Further, applicant maintains the argument, made in the Remarks filed July 14, 2003, that Nguyen is totally irrelevant to claim 8. As applicant's Remarks explained on page 13, Nguyen merely teaches generating a warranty claim report for a particular asset, and offers no teaching or suggestion of reviewing maintenance information for a plurality of assets associated with either an asset supplier or a maintenance organization to evaluate the relationship of the asset owner with either party based on overall maintenance performance, as required by the claims. Accordingly, claim 8 is independently patentable.

Serial No. 09/653,735
Attorney Docket No. 65678-0032

IV. CONCLUSION

Claims 1 - 8 and 12 - 24 are in condition for allowance. It is believed that any additional fees due with respect to this paper have already been identified in any transmittal accompanying this paper. However, if any additional fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge account number 18-0013 in the name of Rader, Fishman and Grauer PLLC.

Respectfully submitted,

Date: October 10, 2003

By: 

Customer No. 010291

Telephone Number (248) 594-0648

Michael B. Stewart, Reg. No. 36,018
Charles A. Bieneman, Reg. No. 51,472
Rader Fishman and Grauer PLLC
39533 Woodward Ave, Suite 140
Bloomfield Hills, Michigan 48304
Attorneys for Applicant

RECEIVED
CENTRAL FAX CENTER

OCT 14 2003

OFFICIAL